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SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1941

No. 1034

RICHARD E. MARINE,

Petitioner,

vs.

CONWAY P. COE, COMMISSIONER OF PATENTS.

PETITION FOR WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR THE
DISTRICT OF COLUMBIA AND BRIEF IN SUP-
PORT THEREOF.

RICHARD E. MARINE,

Pro se.



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RICHARD E. MARINE,

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CONWAY P. COE, COMMISSIONER OF PATENTS.

**PETITION FOR WRIT OF CERTIORARI DIRECTED
TO THE UNITED STATES COURT OF APPEALS
FOR THE DISTRICT OF COLUMBIA.**

*To the Honorable the Chief Justice and the Associated
Justices of the Supreme Court of the United States:*

Your Petitioner, Richard E. Marine, respectfully prays for a writ of certiorari directed to the United States Court of Appeals for the District of Columbia to review a decree of that Court entered November 3, 1941, request for rehearing having been denied on December 3, 1941, or in the alternative to remand the case for further action. A certified transcript of the record in the case including the proceedings of such Court of Appeals, is furnished herewith, in accordance with Rule 38 of this Court. The time for filing this certiorari was extended ten days by this Court.

Summary Statement of the Matter Involved.

1. This is a suit under R. S. 4915 originally brought before the District Court of the United States for the District of Columbia asking that Court to authorize the Commissioner to issue a patent to Petitioner containing appealed claims 5 and 57 of his pending patent application, Serial No. 266, 340, filed March 31, 1928. These claims read as follows:

5. In a vehicle construction in combination; a body post having a face *in alignment* with the driver's line of vision past the same and a *door frame end member* substantially *within* the blind angle *subtended by said post* with the driver's eye.

57. In a vehicle construction, a body post *whose cross-sectional area extends to and is bounded on one side for substantially its full length by the driver's line of vision past said side*, and a window end frame member normally lying within the blind angle *subtended by the post* with the driver's eye. (Emphasis ours.)

2. Said application had been involved with one Wright in Interferences Nos. 61,642 and 61,643, the latter having been a consolidation of the three interferences. Wright had prevailed as to the single count of the first interference and had lost to petitioner the second interference involving four counts.

3. On appeal from the District Court to the United States Court of Appeals for the District of Columbia, that Court "Affirmed upon the findings of fact, conclusions of law, and opinions of the District Court". (51 U. S. P. Q. 540.)

4. In its opinion the District Court held, referring to the decision of the Court of Customs and Patent Appeals in Interference No. 61,642 (32 F. Sup. 236):

"It is considered that this interference count reads on the structure disclosed in plaintiff's claims Nos. 5

and 57, and it would, therefore, seem that such claims are disposed of adversely to the plaintiff by that litigation."

The count in Interference No. 61,642 read as follows:

"In a vehicle construction in combination, a body post provided with a front face substantially in alignment with the driver's forward line of vision past said post; and a windshield end frame member having a front face normally in substantial alignment with the front face of said body post."

We submit that this test of *res adjudicata* has no support under the authorities for reasons set forth hereinafter.

Aside from the propriety of this test for *res adjudicata* we submit that this ruling was improper because it ignored newly discovered evidence presented for the first time to the District Court, not having been previously available to Petitioner since it consisted in an admission made by Wright after termination of Interference No. 61,642 during the subsequent *ex parte* prosecution of his application which was not open to Petitioner until his patent issued thereon on November 24, 1936. This was after Petitioner had presented claim 57 to the Patent Office following termination of said interference and had contended that said claim, and also his original claim 5, distinguished over the subject matter of the Wright disclosure in a patentable sense and that therefore the subject matter of claims 5 and 57 was not *res adjudicata* against Petitioner, as indeed was found as a fact in Interference No. 61,642, but held not to be material to the issue therein, as will later appear.

That the District Court erred in its test adopted for determining *res adjudicata* was cited as error to the Court of Appeals (R. 119, IV, 1) and similarly the error in ignoring the newly discovered evidence was urged on appeal (R. 117, 19, 20, 21).

5. The District Court supplemented its ruling as to *res adjudicata* with the following additional finding [32 F. Sup. 236]:

"If, however, technically, the matter is not *res judicata*, the reasoning employed by the Court of Customs and Patent Appeals in that case compels the same conclusion. The Wright patent provides a front corner post assembly with no greater obstruction to vision and with more supporting strength than those previously employed. The drawings of the Wright patent show the front face of the assembly to be in substantial alignment with the driver's forward line of vision past said post. In so far as the claims of the petitioner relate to one face of the front corner post assembly, there is no critical difference. The plaintiff insists that the assembly disclosed by him in claims 5 and 57 has one face in alignment with the driver's vision, whereas the Wright structure is only substantially bounded by such line of vision, and even this quality is due to the 'accidental' draftsmanship of the drawings in the Wright patent. Laying aside the very complicated argument as to the geometry of the drawings, it suffices that the Wright specifications do show a substantial alignment on one face of the assembly, and that, for practical purposes, is all that plaintiff's structure accomplishes. So the conclusion is reached that the plaintiff is not entitled to the relief sought with respect to claims 5 and 57."

These findings ignore the findings of fact in Petitioner's favor in Interference No. 61,642 and also the newly discovered evidence above referred to. They were cited as error to the Court of Appeals (R. 117, 19, 20, 21; 119, 120, IV, 2, 3, 4, 5, 6, 7).

6. All of the above rulings of the District Court ignore entirely Petitioner's contention that claim 5 was dominated by Interference No. 61,643 in which Petitioner prevailed over Wright as to the subject matter of said claim, cited to

the Court of Appeals as error. (R. 119, 42, 43—it being noted that in line 2 of 42 the interference number 61,642 is a typographical error for 61,643, as clearly established by the fact that the latter interference only was consolidated with numbers 61,644 and 61,645).

7. All of the above questions involve the failure of the lower courts to give proper effect to applicable decisions of this Court and to the requirements of statutes involved. The requirements of R. S. 4888 and the decisions of this Court governing sufficiency of disclosure as laid down in *Permutit v. Graver*, 284 U. S. 52 and *Schreiber-Schroth Co. v. Cleveland Trust Co.*, 305 U. S. 47, and kindred decisions, and R. S. 4886 and the decision of this Court in *Mitchell v. Tilghman*, 86 U. S. 287, requiring utility as essential to disclosure, which the newly discovered evidence involving Wright's own admissions of lack of utility and, indirectly, lack of disclosure, definitely establish, are entirely ignored. Their consideration here necessitates a brief review of the facts established by the record.

8. The invention here at issue relates to an automobile front corner post assembly. Such an assembly is illustrated in Fig. 4 of Carlson patent 1671087 (R. 91). Such assembly comprises a fixed body post 36 extending from the body of the car to the roof and supporting the latter at its front end, together with a door window and frame member 29 which, when the door is closed, abuts the body post, and a windshield end frame member at the lower end of the windshield 38, also contact with the fixed body post 36. The assembly as a whole offers an obstruction to the driver's vision, indicated by the angle A, which is defined as the blind angle since objects beyond the post and lying within this angle are not seen by the driver. It was first pointed out by Emond, patent 1,622,098 (R. 87-89) that if the dimension of the assembly transverse to the driver's vision were

reduced to a dimension not exceeding two and a half inches, this being the interpupillary distance between the driver's two eyes, then the two parallel lines of vision past the assembly would enable him to see any object not smaller than two and a half inches, which became known as clear vision since it would enable the driver to see any object essential to safe driving.

The advantages of this construction for safety both to the occupants of the car and those using the streets and roads were manifest and the advance made in the art received wide acclaim. It had, however, one serious drawback, namely, all parts of the assembly had to be reduced to a minimum of size and the fixed body post itself became so small that it was unable successfully to sustain the loads placed upon it. This was admitted by Emond's assignee (R. 142) wherein it was stated that "one of the great problems has been to accomplish clear vision and still retain stability". Again, Carlson, a foremost body engineer and then vice president of the Dieterich Body Company, formerly makers of custom bodies for Packard, Cadillac and other high grade cars on which this post was installed (R. 61) states in a contemporaneous patent (R. 100, 2nd par.) that to incorporate in the vehicle the imperatively demanded qualities of clear vision presented a real problem if the corner post is to be made of adequate strength. Appellant testified (R. 47, 48, 50) that for many years he had attended automobile salons and shows and talked with these men or their representatives and was also familiar with the circumstances surrounding the attempt to embody clear vision in the New Day Jewett (R. 141) and that this car had failed (R. 49). These difficulties caused the public to give up its demand, then at its height, for clear vision and clear vision cars made by the production method practically disappeared from the market.

9. Petitioner conceived the idea that by departing from the prior practice of building the assembly with an over-all outline rectangular in cross-section and placed in the front corners of the car body with one pair of opposite faces substantially at right angles to the windshield and the other pair of faces parallel therewith, if the cross-sectional outline of the assembly were turned until two of its opposite sides were in alignment with the respective sides of the blind angle, then the fixed body post could be given any strength desired since it would be occupying the entire available space between the sides of the blind angle and there would be no waste space therein as in all prior constructions. Moreover, the assembly could be lengthened to any extent necessary for strength between the sides of the blind angle and longitudinally thereof. This is illustrated, for instance, in Petitioner's Fig. 6 (R. 131) described (R. 128) as follows:

"The construction shown in figure 6 differs from that of figure 3 mainly in that the windshield is moved forwardly, the recess 15" and the windshield frame 16" being made of triangular cross-section contour, as shown, in order to preserve the alignment of opaque members with the driver's line of vision."

It will be observed from Fig. 6 that this parallel arrangement of the sides of the fixed body post itself in alignment with the respective side lines of the driver's vision not only fills out all of the space in the blind angle throughout the length of the assembly but also that this outline is of the post *per se*, the window end frame member of the door and that of the windshield being inset in recesses in the body post itself, which recesses serve as corrugations, further strengthening the post (R. 124, folio 279).

10. Petitioner's original application as filed contained claim 14 (R. 129) which later became the sole count in In-

terference 61,642. This claim was first rejected by the Patent Office on the patent to Carlson 1,671,087 above described as typical prior art. The examiner's theory was that the limitation of this claim to "*substantially* in alignment with the driver's forward line of vision past said post" was met in Carlson's Fig. 4 (R. 91) in which the face of the arm or extension of his main post portion 36 made a substantial angle with the upper side of his blind angle A. On argument that claim 14, like claims 12 and 16, were patentable over Carlson for the reason that the line of vision in the latter passes through a corner or edge only—not through a face, (R. 133) the examiner allowed the claim and suggested it to one Wright for purpose of an interference (R. 149). Although Wright had never previously shown, described or claimed alignment of any face of the post with the driver's line of vision past it, he adopted the claim and an interference was declared.

11. Wright's drawings comprise two figures only, Figs. 1 and 2 which have been reproduced herein as Appendix A and Appendix B, showing these drawings as filed. This has been done because his original drawings reproduced (R. 177) fail to show the original vision lines due to faulty reproduction and his patent drawings (R. 173), have lines added thereto since the date of filing. In fact, his patent description is charged by Petitioner with containing new matter introduced by amendment and therefore it is submitted that only his original specification, reproduced with amendments made thereto apparent (R. 179-182), we submit, should be considered. Defendant has not relied upon these amendments in his previous arguments.

In Appendix A the characters *a* and F1 and in Appendix B the characters *a* and F2 have been added for ease of reference since Wright's disclosure makes no specific reference to these parts.

In Wright's Fig. 1 the vision line 23 here at issue makes a substantial angle *a* with the face F1 of the extension of his post 10. This angle *a* is of the same order of magnitude as the corresponding angle in Carlson's Fig. 4 between the up-side of his angle A and the face of his post extension or arm 39 and no tribunal has ever held that Wright's Fig. 1 supports the count of Interference 61,642 more than does Carlson.

In Wright's Fig. 2 the angle *a* between the face F2 of his post extension 14 and the side line of vision 23, constituting the adjacent side of his blind angle, is much smaller than in Fig. 1 and it is upon this figure that all tribunals have relied for disclosure of a face of the post extension in substantial alignment with the side 23 of the blind angle.

There is nothing whatever in Wright's disclosure about the angular relationship between the face F2 of the post extension in Appendix B and the side line of vision 23 and alignment is not even shown so that the drawing makes no suggestion of alignment, as called for by both of claims 5 and 57 here at issue. This fact was strongly testified to by the expert Mason (R. 26-27) or seriously challenged by Defendant. The disclosure, therefore, is at best accidental. It is accordingly submitted that in the rejection of claims 5 and 57 here at issue, which were not involved in the subject matter of Interference 61,642, as will hereinafter be shown, which claims call for *alignment* and not *substantial alignment*, the tribunals have not given proper effect to, in fact have ignored, the applicable decisions of this Court in *Permutit v. Graver*, 284 U. S. 52 and *Schreiber-Schroth Co. v. Cleveland Trust Co.*, 305 U. S. 47 and kindred decisions.

Not only is this disclosure in Fig. 2 accidental but a consideration of the written description thereof and every action taken in Wright's amendments and arguments prior to the time that the Patent Office revealed Petitioner's disclosure to him by the declaration of Interference No. 61,642

establishes that said showing in Fig. 2 is both a draftman's error and lacking in the utility demanded of a disclosure by R. S. 4886 (Appendix G). In the last paragraph (R. 179), Wright states that his description set forth at length that form of my invention which I had selected for illustration in the drawings accompanying and forming a part of the present specification. In the sentence immediately following (R. 180, beginning line 1) he states that the drawings themselves "show one form" of automobile body embodying my invention. He further states (R. 181, last sentence) that the vision line indicated at 24 is "the center line of vision". It is so shown in Fig. 1, but in Fig. 2 the angle made by the center line 24 with the side of the blind angle 23 is only half of that made by the same center line with the other side of the blind angle 22a. Further Wright's specification (R. 179, folio 1002) states that the average distance of the eye from the post is about twenty inches but the distance of the eye from the post in Fig. 2, when its lines of vision are extended, are only about eight or nine inches from the post (R. 29-30-179, folio 1002). That the line 24 is a center line is claimed in his original claims, e.g., 2 and 3 (R. 143) and by amendment, prior to knowledge of Petitioner's disclosure, he based a claim on the diamond shaped area of Fig. 1 and argued its patentability on this basis (R. 144-145) and in the same amendment he added an additional claim asserting that this area was substantially symmetrical about an axis (R. 145). Moreover every reference to Fig. 2 in his specification refers back to Fig. 1 for its geometry. It needs must follow, we submit, that Fig. 1 is the "one form" of his invention which he intended to disclose.

12. Lack of utility in Wright's Fig. 2 admitted by him.
It is obvious from the above that by making the angle between the side line of vision 23 and the center line of vision 24 only one-half of what it should have been, Wright has

materially diminished the area given over to his post extension 14 and thereby weakened his post extension one-half. This is diagrammatically shown in Appendix D wherein his diamond shape of Fig. 1 is represented by the white area plus the grey area with apex *c* while his Fig. 2 is shown in white only. By the draftsman's error he has reduced the strength of his post extension 14 to the extent of the grey area. The four black corner areas indicated *a* in this figure show the additional strength which would have been added to his post assembly shown in Fig. 1 and represented in this diagram by the white plus the grey areas had he had the foresight to employ Petitioner's concept of alignment of two opposite sides of his assembly with the sides of the blind angle 22a, 23.

The diagram in Appendix C further analyzes these results. Here the heavy outer outline shows Wright's diamond shape of Fig. 1 with the center line 24 a true center line. Its face F1, as shown by the projected direction line B, comes far from passing through the eye of the driver which lies on the line 24 and no idea of alignment between this face and a driver's line of vision is possible. The inner face F2 is that of Wright's post extension shown in Fig. 2 and its line of direction D is also far removed from the direction of the driver's eye. If the area of the post extension is further reduced as shown by dotted lines having the direction extension G it would still not be in alignment with a line of vision from the driver's eye. Alignment could only be secured when the area of the post extension was reduced to zero, bringing the direction line in line with the driver's eye but destroying the post extension. Hence alignment in Wright emphatically spells lack of utility.

All of the above facts are in effect admitted by Wright himself in an argument submitted after termination of Interference No. 61,642 and not available to Petitioner in time to be urged before the Patent Office. It was therefore newly

discovered evidence of which the District Court should have taken notice.

This admission was made in an argument submitted to the Patent Office on December 4, 1935, to justify the showing in his Fig. 2 and is as follows:

“The mentioned diamond-shaped area (Fig. 1) is in practice so much larger than is necessary for strength that the Applicant’s drawing (Fig. 2) shows only the rearward half (door side) of the diamond, with the inside or wind-shield face side approximately in line with the line of vision of a person seated on that side of the car,” (i. e. the driver). (Emphasis and parenthesis ours.)

Strange it is that Wright would intentionally weaken his post where his two and a half inch transverse dimensions would insure clear vision without it, where others had found it impossible to build a clear vision post of adequate strength to render clear vision practicable.

In failing to give consideration to this admission it is submitted that the District Court and the Court of Appeals also failed to give proper effect to applicable decisions of this Court as, for instance, in *Mitchell v. Tilghman*, 86 U. S. 287, 418, where it was said:

“Patent laws have for their leading purpose the encouragement of useful inventions. Practical utility is their object, and it would be strange if, with such object in view, the law should consider two things substantially the same which, practically, and in reference to their utility, are substantially different.” (Emphasis ours.)

13. *Construction given “substantial alignment” in Interference No. 61,642.* Petitioner throughout the progress of Interference No. 61,642 contended that “substantial alignment” meant essentially “alignment” of the character shown in his Fig. 6 and referred to in the written descrip-

tion of said figure, *supra*, and that therefore Wright did not disclose and could not make Petitioner's claim 14 (the sole count of said interference) because he showed an angle of deviation or divergence from true alignment and of the same order of magnitude as in Carlson's Fig. 4 (R. 91) on which said claim had been originally rejected, but afterwards allowed on the ground that "alignment" was not shown therein, nor results flowing therefrom similar to Petitioner's.

The Court of Customs and Patent Appeals, as had also the Patent Office tribunals, in contravention of R. S. 4904 (Appendix I) and the applicable decision of this Court in *Hill et al. v. Wooster*, 132 U. S. 693, and Patent Office Rule 94 (Appendix K), requiring invention as a condition precedent to an interference, refused to consider the meaning given the count necessary to patentably distinguish it over the Carlson patent, *supra*. The Court said:

"There is only one question before us, viz., the right of appellee to make the claim corresponding to the count here in issue. While appellant in his reasons for appeal assigns error by the board in refusing to consider prior art in determining the scope of the claim, that question cannot be considered by us. It is well established that we are not at liberty in a proceeding of this character to inquire whether the interpretation given a count by the Patent Office tribunals renders the count unpatentable over the prior art. *Marshall and Levan-dosky v. Ledwinka*, 21 C. C. P. A. (Patents) 728, 67 F. (2d) 495, and cases therein cited."

All tribunals in said interference denied appellant's contention that "alignment" and "substantial alignment" meant the same thing, namely, "alignment" but held on the contrary that

"the recitation of 'substantial alignment' must be construed to give some latitude" (R. 154, last sentence, R. 170, lines 2-5)."

The examiner of interferences also held that:

"It is true that Wright's post does not fill the space between the sides of the driver's blind angle and therefore Wright does not achieve the result achieved by Marine of maximum strength for a given obstruction to the driver. However, the count is not limited to a post which achieves that result. As far as the limitations are concerned the post might offer great obstruction to the driver's vision and be comparatively weak." (R. 152) (Emphasis ours).

The Court of Customs and Patent Appeals in adopting the "concurring decisions of the Patent Office tribunals" as the basis of its own decision (*Marine v. Wright*, 74 F. (2d) 996) affirmed these holdings. The Court of Customs and Patent Appeals, however, further found that:

"There does seem to be some inconsistency between appellee's Figures 1 and 2 as indicated by the projected lines of vision."

It needs must follow that the Court of Customs and Patent Appeals found that either Wright's Fig. 1 or his Fig. 2, or both, were erroneous. But in view of its affirmance of the Patent Office it must perforce have held that the range of "latitude" given the term "substantial alignment" was sufficient to read *on what Wright actually disclosed when the errors in the drawing were corrected*. Otherwise it would have been the duty of the Court to determine the effect of these errors on Wright's right to make the count, which it failed to do, as did also the District Court and the Court of Appeals when they laid "aside the very complicated argument as to the geometry of the drawings."

But while the Court of Customs and Patent Appeals could justify its failure to determine the extent and scope of the inconsistencies which it found to exist, on the ground of the latitude which, under its construction of the term

“substantial alignment”, it gave to the count in interference, the same justification, we submit, cannot be given the failure of the District Court and the Court of Appeals to determine the geometry of the drawings. This is for the reason that claims 5 and 57 here at issue are not susceptible of the wide latitude of construction given said count, as will presently appear. Moreover, necessity for determining the geometry of Wright's drawings was, as we have shown above, non-existent, because Wright himself meanwhile had substantially admitted that the geometry of Fig. 2 was erroneous and that its true geometry was that of Fig. 1. We submit that it was the duty of the latter courts to consider this newly discovered evidence and that there was no basis whatever, in view thereof, of a holding of *res adjudicata* or even non-patentable difference over Wright in view of the fact that true alignment had already been found to be patentable over Carlson and by the same token was patentable over Wright's corrected drawings.

That claims 5 and 57 are not susceptible of the wide latitude given the interference count follows from the following considerations.

Both claims 5 and 57 specify in effect a body post having a face *in alignment* with the driver's line of vision past the same and a blind angle *subtended by said post* with the driver's eye and claim 5 additionally specifies that the door frame end member lies substantially *within said blind angle*.

Alignment as taught by Appellant and called for by claims 5 and 57 effects the saving of waste space in the blind angle and increases post strength, without increased obstruction to vision. This is not true of Wright's teaching.

Since the blind angle is stated in claims 5 and 57 to be subtended only by the body post, the entire width of the blind angle is given over to the post, alone, rather than to the entire assembly, as in Wright. Appellant's post has

therefore also greater lateral strength than Wright's post 10.

The door end frame member 26 of Wright is not all within the blind angle subtended by the post as stated by claims 5 and 57 but itself subtends a very material part of the blind angle. The width and strength of the body post is correspondingly decreased.

Hence, none of these three features are at all disclosed by Wright or were or could have been adjudicated in Interference No. 61,642. His disclosure therefore cannot be *res adjudicata* against Appellant.

14. Count 5 res judicata in favor of Appellant by reasons of decisions in his favor in Interferences 61,643-5 and estoppel under Rule 109. The combination of claim 5 includes the door as an essential element of the combination. Such combination was not adjudicated in Interference No. 61,642, but was adjudicated in Interferences No. 61,643-5. The presence of the door frame in the combination introduces new and different problems from those of the windshield frame which latter only was adjudicated in Interference No. 61,642. *The door and its window frame must be continuously opened and slammed shut and the frame is subjected to heavy pressure of air which may cause its vibration when running fast.* It, therefore, presents specific problems not inherent in the windshield frame. The solution of these problems is well stated in the following sentence taken from Petitioner's specification, (R. 124-215) :

"Thus a maximum of strength is imparted to the body post, while the door post, *since it is protected in closed or normal running position within the channel in the body post, also partakes of the strength of the latter.*"

Wright's disclosure and drawings fail utterly to show a door frame protected by the post as indicated, or in any

other way, and does not at all satisfy the terms of the claim.

Wright attempted to make count 1 of Interference No. 61,644 by a motion under Rule 109 made in Interference No. 61,643. This claim reads as follows (R. 6):

“A body post assembly comprising a *body post* provided with a face having a vertical channel therein and a *door window end frame member* positioned in said channel when the door is closed, said body post extending a substantial distance inwardly from said channel within the angle subtended by the outer portions of said assembly *with the driver's eyes and in substantial alignment with at least one side of said angle.*” (Emphasis ours.)

Wright's motion was denied and he did not appeal. The decision, therefore, became final and created an estoppel against him as to the door element of the combination. *The Newcomb Motor Company v. Moore, Commissioner of Patents*, 30 App. D. C. 464.

There were further counts 2, 3, involving the door window frame as counts in Interference No. 61,644, which Wright did not attempt to make (R. 6). Count 2 reads as follows:

“2. In a body post assembly, a body post having a vertical channel therein whose outer edges lie in substantial alignment with the driver's eye; and a *door window end frame member* lying substantially within said channel when the door is closed.”

Failure to make these counts 2 and 3 or similar counts appropriately modified created an estoppel against him under Patent Office Rule 109 (Appendix M).

Moreover, original claim 5 (R. 129) in substantially its present form was an original claim in Appellant's application and the failure of Wright to make it under the provisions of Rule 109 also created an estoppel against him (R. 129).

We, therefore, submit that claim 5 was not properly denied Petitioner on Wright's disclosure on the ground of estoppel but it is rather Wright who would be estopped to make said claim.

Jurisdiction.

This suit is brought under the provisions of Sec. 4915, R. S., U. S. Title 35, Sec. 63 U. S. Code and the jurisdiction of this Court is invoked under Title 28, Sec. 347 U. S. Code. The original decision of the Court of Appeals was rendered on November 3, 1941 (R. 186) and a petition for rehearing was denied on December 3, 1941 (R. 187). A motion by petitioner for additional time to file this petition was granted by this Court, through Chief Justice Stone, and such time was extended to March 13, 1942 (R. 189).

In support of such jurisdiction the decision *Baldwin v. Robertson*, 265 U. S. 168, 181 is cited.

The Questions Presented.

1. Is the fact that a count of a former interference is readable on the structure disclosed in a claim of a losing party a proper test of *res adjudicata* against the allowability of said claims to said party?

2. Where an interference was declared with a certain claim as its count only after the primary examiner, as a condition precedent to his right, under R. S. 4904 (Appendix I) and Patent Office Rule 94 (Appendix K), to put said claim in an interference, had given said claim a special construction rendering it patentably different from the disclosure of a particular patent on which it had been previously rejected when not given that construction, can an interference tribunal properly refuse consideration of the construction placed by the examiner on said claim when allowing it?

3. Can, after termination of the interference, the *ex parte* tribunals having jurisdiction revert to the original construction given the count by the primary examiner before the declaration of the interference, but a different construction from that given it by the interference tribunals in deciding priority, to support a holding of *res adjudicata* against a losing party as to other claims not adjudicated and limited definitely to the original *ex parte* meaning of the count which was adjudicated on a different meaning, particularly where said other claims define a structure not disclosed by the winning party?

4. Can a tribunal of the United States having proper judicial jurisdiction over patent cases ignore a manifestly applicable decision by this Court laying down rules to determine the sufficiency of disclosure required in applications, and patents resulting therefrom, by R. S. 4888 (Appendix H)?

5. Can a tribunal of the United States having proper judicial jurisdiction over patent cases ignore a manifestly applicable decision by this Court holding that a disclosure lacking in utility required by R. S. 4886 (Appendix G) is invalid as an anticipation?

6. Were petitioner's claims 5 and 57 properly denied him under the facts set forth in the statement of the case?

7. Were petitioner's claims 5 and 57 properly denied him under the principles involved in questions 1 to 5?

Reasons Relied On for the Allowance of the Writ.

1. Question 1 relates to the subject matter of paragraph 4 of the petition-statement. It is of paramount importance, we submit, to all inventors in general and to those who become involved in litigation in particular, of whatever sort, since the successful prosecution of a broad claim

could foreclose all protection on improvements of others in his art. It would become impossible for the loser of an interference, for instance, to obtain protection on the most specific type of improvement never contemplated by his adversary. Had the radio art been extensively developed during the life of the Bell Telephone patent it would appear that the rule stated by the District Court and Court of Appeals would have barred any protection on the most specific improvements in radio never contemplated by Bell.

Questions 2 and 3 bring into issue whether the rule of count construction in interferences wherein the construction given by the examiner in differentiating a claim over particular patents is ignored notwithstanding the requirement of R. S. 4904 that invention be found as a condition precedent to the determination of the question of priority of invention. This is also required by applicable decisions of this Court, *e. g.*, *Hill et al. v. Wooster*, 132 U. S. 693. Patent Office Rule 122, as amended (Appendix L, 2nd paragraph), recognizes this principle in the case where the claim of a patent is involved in interference and no reason is apparent why this same rule should not be extended to counts taken from pending applications and the failure to extend the rule is discriminatory. We submit that the existence of a patent renders the rule no more sacred than in the case of pending applications where the technical and harsh application of the rule of *res adjudicata*, as here, ignores the truth due largely to the confusion of issues resulting from a change in rules of the game during its progress. Applicants having pending applications rather than patents are liable to serious injury in passing the Scylla of different constructions of the same claim in a continuous proceeding only to be utterly destroyed by the Charybdis of *res adjudicata*, thereafter. Of the several hundred interferences finally decided on priority each year

the question of claim construction is generally involved and the rights to many important inventions are at stake. A patent claim is not "like a nose of wax which may be turned and twisted in any direction." If during the progress of an interference it appears that a former construction given the claim by the examiner in formulating the issue to be contested on priority cannot be accepted by a tribunal passing upon the question of priority in interference the interfering counts can and, we submit, should be re-formulated (*Podelsak v. McInnery*, 26 App. D. C. 399, 408). This Court has many times had occasion to modify the rules governing the practice in pending applications established by the tribunal having jurisdiction thereover. In the *Cornplanter case*, 90 U. S. 181, it overruled and abolished the practice of rejecting applications on prior abandoned applications; in *Miller v. Brass Co.*, 104 U. S. 350, and in *James v. Campbell*, 140 U. S. 356, it limited the time within which broadened reissue claims could be presented; in *Steinmetz v. Allen*, 192 U. S. 543, it declared invalid one of the rules of the Commissioner requiring division between claims for a process and claims for an apparatus; in *Chapman et al. v. Wintroath*, 256 U. S. 126, it held that the Commissioner would not restrict by rule the time within which claims of a patent could be copied for interference by an adversary to the period of one year after grant of the patent (under old statutes); and in *Milburn Co. v. Davis Co.*, it held that the filing of an application upon which a patent was granted fixed the effective date of the patentee's invention as of that date.

Relative to Question 4 it is submitted that the decision of the Court of Appeals herein does not give proper effect to the applicable decisions of this Court, *e. g.*, *Permutit v. Graver*, 284 U. S. 52; *Schreiber-Schroth Co. v. Cleveland Trust Co.*, 305 U. S. 47; nor with respect to Question 5 to *Mitchell v. Tilghman*, 86 U. S. 287, 418. These are salutary

decisions necessary to the prevention of fraud and, we submit, that disregard of them should be discouraged.

Questions 6 and 7 involve the application of the above principles to the instant case. This case involves the item of safety by clear vision with adequate strength and these factors have been considered most important in the art. The District Court stated that improvements in this field should be stimulated and recognized (R. 111). A similar view was expressed by the Court of Appeals of the District of Columbia in *Meyers v. Coe*, 83 F. (2d) 708.

WHEREFORE, your petitioner, feeling himself aggrieved by the decree of the United States Court of Appeals for the District of Columbia, respectfully prays that a writ of certiorari be issued out of and under the seal of this Honorable Court, directed to the said United States Court of Appeals for the District of Columbia commanding that court to certify and send to this Court for its review and determination, on a day certain to be herein named, a full and complete transcript of the record and all the proceedings in the case, numbered and entitled on its docket, No. 7737, *Richard E. Marine, Appellant v. Conway P. Coe, Commissioner of Patents, Appellee*, and that said decree of the said United States Court of Appeals for the District of Columbia may be reversed by this Honorable Court and that petitioner may have such other and further relief in the premises as to this Honorable Court may seem meet and just, and your petitioner will ever pray.

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Of Counsel.



**PETITIONER'S
BRIEF**



SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1941

No. 1034

RICHARD E. MARINE,

Petitioner,

vs.

CONWAY P. COE, COMMISSIONER OF PATENTS.

**SUPPORTING BRIEF ON PETITION FOR
CERTIORARI.**

I. Opinions of the Courts Below.

The opinion of the United States Court of Appeals for the District of Columbia in this case was rendered November 3, 1941, (R. 186) petition to rehear was denied December 3, 1941 (R. 187) and the opinion is reported in 51 U. S. P. Q. 540. The opinion of the District Court of the United States for the District of Columbia is reported in 32 Fed. Sup. 236 and also appears upon pages 109-111 of the transcript of record.

The opinion of the Court of Customs and Patent Appeals upon which the opinion of the District Court was based, is reported as *Marine v. Wright* in 74 F. (2d) 996.

II. Jurisdiction.

This suit is brought under the provisions of Sec. 4915, R. S., Title 35, Sec. 63, U. S. Code, and the jurisdiction of this Court is invoked under title 28, Sec. 347, U. S. Code.

In support of the jurisdiction the decision in *Baldwin v. Robertson*, 265 U. S. 168, 181 is cited.

III. Statement of the Case.

All that is material to the consideration of the questions here presented, with appropriate page references to the printed record, is believed to have been set forth under "Summary Statement of the Matter Involved" in the petition for writ of certiorari, in sections numbered 1 to 14, inclusive, to which reference is here made.

IV. Specification of Errors.

The United States Court of Appeals for the District of Columbia, following the findings of fact and law and the opinion of the District Court of the United States for the District of Columbia erred in:

1. Holding that the readability of a count lost in interference on the structure disclosed in claims not involved therein is a test of *res adjudicata* against the losing party (R. 119, IV, 1).
2. Not holding that petitioner's claims 5 and 57 are free from the charge of *res adjudicata* by reason of the outcome of Interference No. 61,642 (R. 117, 24).
3. Not holding that claims 5 and 57 patentably distinguish over Wright's actual disclosure (R. 117, 25).
4. Not condemning the practice of the Patent Office in adjudicating a count which had not been found to be patentable, due to the fact that it was given a different construc-

tion in interference from that which the primary examiner had found allowable (R. 118, 31-36).

5. Resorting to the construction given petitioner's original claim 14 in finding it patentable over Carlson rather than the construction given it in interference in determining *res adjudicata* (R. 119, 37-39).

6. Failing to consider newly discovered evidence in the form of Wright's admission in his application record after termination of Interference No. 61,642, establishing lack of utility in his disclosure in Fig. 2, solely relied upon as anticipation by all tribunals (R. 117, 19-22), and therefore failing to give proper effect to applicable decisions of this Court.

7. Failing to consider this newly discovered evidence together with other evidence in Wright's record fully establishing accident and error in Wright's Fig. 2 (R. 116, 117, 13-21), and therefore failing to give proper effect to applicable decisions of this Court.

8. Holding that there is no critical difference between alignment and substantial alignment (R. 120, 4).

9. Holding that the geometry involved in Wright's case should be laid aside (R. 120, 5).

10. Holding that for practical purposes plaintiff's structure accomplishes no more than the substantial alignment of Wright (R. 120, 6).

11. Not holding that claim 5 is *res adjudicata* in favor of petitioner by reason of the adjudication in his favor in consolidated interference No. 61,643 (R. 119, 42-43), and also by the failure of Wright to make said claim, under Patent Office Rule 109, which was in petitioner's application as filed and during the progress of the interference (R. 119, 43).

12. Not allowing claims 5 and 57 to petitioner.

V. Argument.

Petitioner's position relative to errors 1 and 2 is substantially the same as that to question 1 of the petition (p. 18, *supra*) and is stated under 1, page 19 of said petition.

His position with reference to errors 3, 8, 9 and 10 is set forth on pages 12 to 16 of the petition.

His position relative to errors 4 and 5 is set forth beginning in the middle of page 20 and ending at the bottom of page 21 of the petition.

His position as regards error 6 is set forth under 12, beginning page 10 and ending on page 12 of the petition.

His position relative to error 7 is based on the facts set forth under 11 on page 8 of the petition and extending to 12 on page 10.

As there set forth Wright's application disclosed two figures, Fig. 1 and Fig. 2, that were stated in the specification to be the same but which actually differed materially on the windshield side of the assembly in the angular relationship of the parts to each other in the respective figures. Wright's record before declaration of Interference No. 61,642 never described or claimed the angular relationship shown on the windshield side of Fig. 2 although he had broadly shown, described and claimed that of Fig. 1, having claimed the cross-sectional area of his assembly as being diamond-shaped and symmetrical about the "center" line 24, none of which description was consistent with or could be reconciled with the windshield side of his Fig. 2. Nevertheless his Fig. 1 was never relied upon in Wright's arguments or by any tribunal in Interference No. 61,642 to support the count thereof, and indeed to have done so might have brought the interfering count under the disclosure of Fig. 4 of Carlson over which the count had been distinguished. However, this may be it is certain that there is

no description of Wright's Fig. 2 fixing the value of the angle *a* therein on the windshield side of his assembly (Appendix B). The expert Mason so testified (R. 26-27) and the original specification and claims clearly establish the fact.

All tribunals below, in relying only on the Fig. 2 drawing to support their conclusion and in refusing to consider the charges of accident and error in said figure, much less Wright's own admission after termination of Interference No. 61,642, have ignored the principles established in applicable decisions of this Court governing the determination of disclosure under R. S. 4888 and holding that a drawing alone is not a sufficient disclosure. Much more is this true where its accuracy has been impeached.

As stated by the Court in *Permutit v. Graver*, 284 U. S. 52, 60:

“Moreover, while drawings may be referred to for illustration and may be used as *an aid in interpreting the specification or claim, they are of no avail where there is an entire absence of description of the alleged invention or a failure to claim it.*” (Citing authorities.)

The still more recent decision of this Court in *Schreiber-Schroth Co. v. Cleveland Trust Co.*, 305 U. S. 47, is directly in point. In that case there was involved the question of whether or not a drawing showing a piston provided with webs and a split skirt, as to which the description emphasized the property of rigidity, was flexible within the meaning of that term as employed by another who showed in his drawings substantially the same structure but explicitly described its property as flexible. While admitting that the first structure, though described as possessing rigidity would inherently possess some flexibility, the Court held that the absence of a written description emphasizing this property

and its purpose rendered the disclosure of the first structure insufficient. The Court said (p. 58) :

“The properties of any given material are many and diverse. The antithetical qualities of rigidity and flexibility of a structure are not absolute but relative; it may be more rigid than some and more flexible than others; too rigid for some purposes and too flexible for others. The one quality may be increased and the other diminished by choice of materials from which the structure is made and by variation in its proportions. *If invention depends on emphasis of one quality over the other, as the court below found was the case with the laterally flexible webs in the Gulick device, the statute requires that emphasis to be revealed to the members of the public, who are entitled to know what invention is claimed. That is not accomplished either by naming a member having inherent antithetical properties or by ascribing to it one property when the other is meant.*” (Italics ours.)

This case bears another very striking resemblance to the instant case in that the question of estoppel by reason of adjudications in prior interferences was at issue. The Court in effect held that the *requirements of Revised Statute 4888 for explicit written description were of greater force than prior adjudications in interferences.* The Court said (pp. 59, 60) :

“We recognize the weight to be attached to the determinations in the interference proceedings in which the Court of Appeals of the District of Columbia and the Court of Customs and Patent Appeals sustained the Gulick amendments. Cf. *Radio Corporation v. Radio Laboratories*, 293 U. S. 1, 7. But the decisions in those cases are not controlling here. So far as the courts relied on the inherent flexibility of the webs to supply the feature of lateral flexibility omitted from the Gulick description *they ignored the principle recognized in Permutit v. Graver Corporation, supra, and*

Powers-Kennedy v. Concrete Co., supra. So far as they relied on the drawings to supply the omission they disregarded the fact shown both by inspection and by the evidence presented here that the drawings do no more to point to Gulick's invention than does the fact of inherent flexibility. We conclude that respondent can take no benefit from the flexible web element added by amendment to the Gulick application."

Petitioner's position relative to error 11 is set forth under 14, beginning page 16 and ending at the top of page 18 of the petition.

It is respectfully submitted, therefore, that this Court should take jurisdiction of this case, reverse the decree of the United States Court of Appeals for the District of Columbia and direct that a new decree be entered by the District Court of the United States for the District of Columbia, authorizing the Commissioner of Patents to issue a patent to Petitioner.

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